

## **REMARKS**

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected and remain pending. Claims 2-4, 6, 9, 13-16, 19, and 22-27 were canceled in previous responses. Claims 1, 5, 7, 8, 11, 12, 17, 18, 20, and 21 were previously amended. No claims are amended herein. Applicant respectfully requests consideration of the following remarks and allowance of the claims.

### *35 U.S.C. § 103 Rejection*

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,718,551 (Swix) in view of U.S. Patent No. 5,822,018 (Farmer) in view of U.S. Patent No. 6,698,020 (Zigmond) in view of “NDS:NDS’XTV™ time shifting technology empowers the viewer and the broadcaster,” M2 Presswire, September 10, 1999, (XTV), and further in view of U.S. Patent No. 6,588,015 (Eyer). Applicant respectfully traverses the rejection because the cited references are mischaracterized in several respects and because six dependent claims were not addressed.

Claim 1 recites, in part, *transferring the insertion point to the target viewer device over the second transport system where the first transport system uses greater bandwidth for video transfer than the second transport system*. The Final Office Action concedes that Swix “failed to teach the insertion point is transferred to the target device via the second transport system which uses less bandwidth” (pg. 6, lines 3-5). The Final Office Action asserts these limitations are taught by Farmer (Id.). However, this assertion is a mischaracterization of Farmer in at least the following respects.

First, Farmer does not teach two transport systems which separately transport video data and an insertion point to a single target device as recited in claim 1. Farmer teaches a single device which transfers cue tones and program material to two separate locations (Farmer, fig. 1). Earth Station Receiver 21 transfers cue tones to Ad-Insertion System 24 over link 23. Earth Station Receiver 21 also transfers program material to Switch 25 and Modulator 30 over link 22 (Id.). Farmer does not teach transferring the selected video content *and* an insertion point to a single *target viewer device* over

separate transport systems as recited in claim 1. In Farmer, the target viewer devices exist in the area to the right of figure 1 entitled “to cable distribution system and subscribers.” Only a single transport system exists between Farmer CTV System 20 and those target viewer devices. Therefore, it is not possible for Farmer to teach *transferring the insertion point to the target viewer device over the second transport system* as asserted in the Final Office Action because Farmer has no second transport system connecting the CTV system to the target viewer devices.

Second, the cue tones used in Farmer cannot be analogized to the claim 1 *insertion points* which *comprise data indicating where in the selected video content the selected video advertising is to be inserted*. The Farmer Ad-Insertion system is triggered when cue tones are transferred to Ad-Insertion System 24. “[I]n response to appropriate cue tones on line 23, ad-insertion system 24 automatically inserts commercials into advertising blocks by spooling advertising material” (Farmer, col. 4, lines 49-51). The cue tones are simply signals which instruct the ad-insertion system to perform a specific function at the immediate time. The cue tones do not contain information relating to specific positions within the selected video content. Only Earth Station Receiver 21 knows how the timing of the cue tones relates to particular locations within the selected video content. Because the cue tones themselves do not contain information identifying particular locations in the selected video content, they cannot be analogized to *insertion points* which *comprise data indicating where in the selected video content the selected video advertising is to be inserted*.

The two issues discussed above with respect to Farmer cannot be resolved in their entirety by citing Swix, Zigmond, XTV, or Eyer. The Notice of Panel Decision from Pre-Appeal Brief Review issued on 11/18/2009 indicates that the Panel had determined the application was allowable over Swix, Zigmond, XTV, and Eyer.

Claim 1 additionally recites *wherein the first transport system uses greater bandwidth for video transfer than the second transport system*. In response to Applicant’s argument that this limitation is not taught or disclosed in the cited references, the Final Office Action reiterates the assertion that this limitation is taught by Swix at columns 12 and 13 (Final Office Action, pg. 5, lines 13-17). However, Swix does not teach using a transport system for the selected video advertising which has a smaller

bandwidth than the transport system used for the selected video content. Swix makes no reference to the relative bandwidths of the video transport systems.

The Final Office Action also states that the method recited in claim 1 is obvious because “the difference between the claimed subject matter and the prior art” can be resolved through “substitution of the second transport system of the secondary reference(s) for the first transport system of the primary reference” (Final Office Action, pg. 6, last ¶). However, this statement is inaccurate because, as discussed above, the second transport systems of the secondary references do not transfer *insertion points* which *comprise data indicating where in the selected video content the selected video advertising is to be inserted to target viewer devices*.

Therefore, for at least the reasons discussed above, Applicant contends that independent claim 1 is allowable in view of the combination of Swix, Farmer, Zigmond, XTV, and Eyer, and such indication is respectfully requested.

Independent claim 12 contains limitations similar to those discussed above with respect to claim 1, and is therefore allowable over the art of record for at least the same reasons as claim 1.

Dependent claims 7, 8, 11, 17, 18, and 21 are referenced generally in the text of the Final Office action (page 2, last ¶). However, no discussion of the limitations of these claims or explanation of the rejection of these claims is provided. This issue was raised in Applicant’s response filed May 18, 2010, but no reply was provided in the Final Office Action. Because these claims have not been addressed, Applicant requests a Non-Final Office Action is granted if the claims are not allowed in this action.

Claims 5, 7, 8, 10, 11, 17, 18, 20, and 21, while separately allowable over the art of record, depend from otherwise allowable independent claims 1 and 12. Applicant therefore refrains from further discussion of these dependent claims for the sake of brevity.

Therefore, in light of the discussion above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21.

## **CONCLUSION**

Based on remarks above, Applicant submits that the claims in their present form are allowable over the art of record. Additional reasons in support of patentability exist, but such reasons are omitted in the interests of clarity and brevity. Applicant respectfully requests allowance of the claims at the Examiner's earliest convenience. If the claims are not allowed, Applicant respectfully requests that a Non-Final Office Action is granted in light of the comments above.

Applicant believes no fees are due with respect to this filing. However, should the Office determine that fees are necessary, the Office is hereby authorized to charge Deposit Account No. 21-0765 accordingly.

Respectfully submitted,

/Todd C. Adelmann/

**SIGNATURE OF PRACTITIONER**

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